

REMARKS

The Applicant respectfully requests reconsideration and Allowance of Claims 1-20 in view of the amendments above and the following arguments.

35 U.S.C. §103 REJECTIONS

Claims 1, 3-5, 6, 10, 11 and 14-18 were rejected under 35 U.S.C. §103(a) as obvious over Berg et al. (US patent 6,362,897, "Berg") in view of Martin et al. (US patent application 2002/0046195, "Martin").

Claim 2 was rejected under 35 U.S.C. §103(a) as obvious over Berg in view of Martin and in further view of Evanicky et al. (US patent 6,657,607, "Evanicky").

Claims 6 and 15 were rejected under 35 U.S.C. §103(a) as obvious over Berg in view of Martin and in further view of Mansutti et al. (US patent 5,748,511, "Mansutti").

Claim 8, 9, 12, 13, 19 and 20 were rejected under 35 U.S.C. §103(a) as obvious over Berg in view of Martin and in further view of Smith (US patent 5,995,942, "Smith").

STATUS OF THE CLAIMS

Claims 1-20 remain pending in this case.

Independent Claims 1, 10 and 17 have been amended to clarify the limitation that Applicant's invention consists of a unitary business machine within which all the elements of the device, the data storage, the display, the selector and the printer, are located. These amendments represented clarifications and do not add further limitations to the respective claims.

CLAIMS 1-20 ARE NOT OBVIOUS IN VIEW OF THE CITED ART

A. The Examiner rejected Claims 1, 3-5, 6, 10, 11 and 14-18 under 35 U.S.C. §103(a) as obvious over Berg et al. (US patent 6,362,897, "Berg") in view of Martin et al. (US patent application 2002/0046195, "Martin").

Applicant respectfully traverses these rejections on the ground that Berg in combination with Martin does not suggest Applicant's invention as claimed and, further, there is no suggestion in Martin to modify the Berg device in the manner claimed.

THE BERG PATENT

The Berg patent discloses a printing system for printing documents and forms (Abstract). The Berg processor 22 communicates with monitor 12 and memory 14 over lines 24, 26, 26 and 28 (Column 5, lines 34-37) and is connected to printer 30 via line 32. (Column 5, lines 41-42). A communications link 38 links processor 22 to a host computer or other communications system via telephone lines. (Column 5, lines 65-67). Nowhere is it disclosed or suggested that all of these items are contained in a single, unitary, business machine. In fact, Berg discloses the common use of communication lines to connect various separate and remote elements together. As a result, Applicant respectfully submits that Berg does not, either alone or in combination, teach or suggest Applicant's invention as claimed.

THE MARTIN ET AL. PUBLICATION

The Martin publication discloses a method for obtaining a postage stamp at a kiosk, where the kiosk includes a computer system and a printer, wherein a user inputs into the kiosk a request for a postage stamp. The request is sent to a remote server via a communications network and the user receives a response back from the server at the kiosk. (Abstract). As with Berg, Martin describes a computer network 100 that includes at

least one kiosk 104, at least one postage vendor system (PVS) 102 and a postal authority system (PAS) 106 coupled to a communications network 108 via a plurality of communication links 110. [paragraph 0036]. Nowhere is it disclosed or suggested that all of these items are contained in a single, unitary, business machine. In fact, Martin again discloses the common use of communication lines to connect various separate and remote elements together. As a result, Applicant respectfully submits that Martin does not, either alone or in combination, teach or suggest Applicant's invention as claimed.

CLAIM 1

In contrast to the techniques of Berg and Martin which are essentially systems for the printing of items via a communication system connecting all the remote and separate parts of their systems, Applicant's Independent Claim1 (as well as Independent Claims 10 and 17) is directed to electronic data storage in a unitary business machine with a top, bottom, front, back and two sides, for storing preselected customized forms. A display on the unitary business machine is connected to the data storage for displaying stored forms. A selector on the unitary business machine is connected to the data storage for selecting forms from the display and an integral hard copy printer in the unitary business machine is connected to the data storage for printing a hard copy of said forms as selected. These limitations are set forth throughout the application as at Figure 1; page 4, lines 1-20; and page 5, lines 2-9, for example.

No such system is disclosed or suggested whatsoever by Berg and Martin either alone or in combination. The Examiner concedes that Berg does not teach Applicant's integral printer but submits that Martin supplies the missing element. But , as set forth above, Berg in fact does not disclose a unitary business machine as required. Both Berg and Martin are connected to various critical elements via communication links in order for

them to operate at all. No stand alone machine is disclosed or suggested by either and the combination does not overcome their deficiencies

Also, in order to combine prior art references or modify a prior art reference under 37 U.S.C. 103, there must be some teaching or suggestion in the prior art to make the combination or modification. In this case, the Examiner does not point to any teaching or suggestion in the prior art to add the printer in Martin to Berg other than to say it would have been obvious to "make the printer integral to the system" (Page 3 Office Action) and that "the motivation to do so would have been to make a self-contained printing system and to facilitate ease of operation and handling." (Page 3 Office Action). However, Berg does not disclose a unitary business machine, as set forth above, and adding an integral printer does not make it one. Most importantly, adding the so called integral printer of Martin as the Examiner suggests would necessarily change the principle of operation of the Berg system. That is, Berg is an already functioning printing system. The addition of a printer is superfluous as Berg already includes a printer 30 connected to the rest of the Berg system by connection 32 through CPU 22 (Figure 1) and the issue remains as to where would it be added to make it an integral printer?

If the proposed modification of the prior art would change the principle of operation of the prior art device, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F. 2nd 810, 123 U.S.P.Q. 349 (CCPA 1959) (see MPEP § 2143.01 at page 2100-99, second column). In the present case, it is clear that if any additional printer is to be functional then the principle by which Berg operates must be changed. Thus, in accordance with *In re Ratti*, it could not have been obvious to make the Examiner's proposed modifications.

The Applicant therefore respectfully submits that Claim 1, as well as independent Claims 10 and 17 which require limitations similar to those in Claim 1, are not anticipated by, nor obvious over, Berg either alone or in combination with Martin and are entitled to allowance along with dependent claims 2-9; 11-16; and 18-20 respectively.

B. The Examiner rejected Claim 2 under 35 U.S.C. §103(a) as obvious over Berg in view of Martin and in further view of Evanicky. The Examiner admits that Berg and Martin together do not teach or suggest Applicant's invention as set forth in claim 2 but states that Evanicky discloses a mounting bracket for mounting a desktop display to the wall. (Page 5 Office Action). The Examiner says the motivation to add the wall mount would have been to install his printing system off the table and on the wall to avoid the need for a table top for placing his printing system. Applicant respectfully disagrees. Applicant incorporates the remarks made above with regard to Berg and Martin. Berg and Martin do not alone or together disclose a unitary business machine. Evanicky discloses mounting the desktop display 36 to a wall not a printer. In fact Evanicky is directed only to a liquid crystal flat panel display and Applicant found no mention of a printer of any sort in Evanicky. In any event, Applicant submits that suspending one part or the other of any of the cited references still does not result in Applicant's unitary business machine. As a result, Applicant respectfully requests that claim 2 be reconsidered and allowed.

C. The Examiner rejected Claims 6 and 15 under 35 U.S.C. §103(a) as obvious over Berg in view of Martin and in further view of Mansutti. The Examiner admits that Berg and Martin together do not teach or suggest Applicant's invention as set forth in claims 6 and 15 but states that Mansutti discloses a battery pack 25 to operate the portable computer having a memory, display, printer, etc.. (Page 6 Office Action). Applicant respectfully disagrees. Applicant incorporates the remarks made above with regard to Berg and Martin. Berg and Martin do not alone or together disclose a unitary business machine. Mansutti discloses a battery pack but the combination with Berg and Martin can not, as set forth above, result in the unitary business machine as set forth in Applicant's claims. As a result, Applicant respectfully requests that claims 6 and 15 be reconsidered and allowed.

D. The Examiner rejected Claims 8, 9, 12, 13, 19 and 20 under 35 U.S.C. §103(a) as obvious over Berg in view of Martin and in further view of Smith. The Examiner admits that Berg and Martin together do not teach or suggest Applicant's invention as set forth in

claims 8, 9, 12, 13, 19 and 20 but states that Smith discloses the missing paper holder elements of these claims. Applicant respectfully disagrees. Applicant incorporates the remarks made above with regard to Berg and Martin. Berg and Martin do not alone or together disclose a unitary business machine. Smith does not supply the missing elements. Smith only discloses paper 42 supplied from a supply role 44 which is threaded around a fixed tube 45 and is supported above the printer 12 by a pair of paper holder arms 46. Mechanism 58 supplies a reverse curl to the paper 42. (Column 6, lines 16-42). As a result, Applicant respectfully requests that claims 8, 9, 12, 13, 19 and 20 be reconsidered and allowed.

CITED BUT NON-APPLIED REFERENCES

The subsidiary references have been reviewed but are submitted to be less relevant than the relied upon references.

CONCLUSION

In light of the above, Applicant respectfully requests reconsideration and allowance of Claims 1-20. If the Examiner should feel that any issue remains as to the allowability of these claims, or that a conference might expedite allowance of the claims, the Examiner is asked to telephone the undersigned attorney.

Applicant intends this to be a complete response. No fee is believed due; however if a fee is due, please charge deposit account number indicated on the transmittal letter.

Respectfully submitted,

J. Nevin Shaffer, Jr., P. A.

Date: 27 April 2005

By: J. Nevin Shaffer, Jr.

J. Nevin Shaffer, Jr., Reg. No. 29,858
913 Gulf Breeze Parkway, Suite 43
Gulf Breeze, FL 32561
850-934-4124
ATTORNEY FOR APPLICANT

Certificate of Facsimile transmission

I hereby certify that this correspondence is being transmitted to the patent and Trademark Office facsimile number (703) 872-9306 on 27 April 2005. Number of Pages, including Transmittal Letter, 12 pages.

Reg. No. 29,858, J. Nevin Shaffer, Jr. J. Nevin Shaffer, Jr.